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OFFICE OF PETITIONS

In re Application of :
Neuhaus et al. : DECISION ON PETITION
Application Number: 10/520681 :
Filing Date: 01/07/2005 :
Attorney Docket Number: :
2002P03767WOUS :

This is a decision on the renewed petition filed on April 24, 2009, under 37 CFR 1.137(a),¹ to revive the above-identified application. This is also a decision on the petition under 37 CFR 1.137(b) filed on April 24, 2009.

The petition under 37 CFR 1.137(a) is again dismissed.

The petition under 37 CFR 1.137(b) is granted.

The application became abandoned on July 16, 2008 for failure to timely file a response to the non-final Office action mailed on April 15, 2008, which set a three (3) month shortened statutory

¹ A grantable petition under 37 CFR 1.137(a) must be accompanied by:

(1) the required reply, unless previously filed; In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(1);

(3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

period for reply. Notice of Abandonment was mailed on January 22, 2009. The petition filed on January 30, 2009, was dismissed on February 24, 2009.

PETITION UNDER 37 CFR 1.137(a)

Petitioners again assert that the non-final Office action mailed on April 15, 2008, was never received. In support, a declaration was provided with the original petition by Tracey A. Daniel, counsel's Patent Assistant, stating that a search of the file jacket and docket record where the non-received Office communication would have been stored and entered was made and the search indicates that the Office communication was not received. The declaration states that a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed, is attached hereto.

On January 30, 2009, the petition was dismissed without prejudice to reconsideration pending submission of a statement by the practitioner in accordance with MPEP 711.03(c). Specifically, MPEP 711.03(c) requires that the practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. Additionally, the petition did not address whether or not the docket report provided was a master docket, pursuant to MPEP 711.03(c).

In the subject renewed petition, petitioners argue that the statement signed by counsel's paralegal as opposed to the practitioner "should be sufficient to meet the requirements of 37 CFR 1.137(a)."

Petitioner's argument has been carefully considered, but is not persuasive. At the outset, petitioners have not adequately explained why they are unable, or unwilling, to provide a statement signed by the practitioner as set forth in MPEP 711.03(c). In the absence of an adequate explanation, the failure to provide such a statement leads to a conclusion that the cause of the delay was not unavoidable.

While petitioner is correct that the determination of unavoidability is to be decided on a case by cases basis in accordance with Smith v. Mossinghoff, 671 F.2d 533, 538 (D.C. Cir. 1982) and Haines v. Quigg, 673 F. Supp. 314, 317 (N.D. Ind. 1987), decisions on reviving abandoned applications have adopted

the reasonably prudent person standard in determining if the delay was unavoidable.² However, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.³ Simply put, the burden is on the petitioner, rather than on the Office, to show that the delay is unavoidable.

Thus, in the absence of a statement by the practitioner in accordance with MPEP 711.03(c), or a sufficient explanation as to why such statement cannot be provided, the Office is unable to conclude that the delay was, in fact, unavoidable. Accordingly the petition under 37 CFR 1.137(a) is again dismissed.

PETITION UNDER 37 CFR 1.137(B)

The statement contained in the instant petition does not set forth that the entire delay from the due date of the required reply to the date of the filing of a grantable petition was unintentional as required by 37 CFR 1.137(b)(3). However, the statement contained in the instant petition is being so construed. Petitioner **must** notify the Office if this is not a correct interpretation.

It is noted that petitioner has requested that only the difference in fees between the petitions under 37 CFR 1.137(a) and (b) be charged.

In this regard, MPEP 711.03(c) states that:

35 U.S.C. 41(a) (7) provides that a petition for the revival of an unintentionally abandoned application or for the unintentionally delayed payment of the issue fee must be accompanied by the petition fee set forth in 37 CFR 1.17(m), unless the petition is filed under 35 U.S.C. 133 or 151 (on the basis of unavoidable delay), in which case the fee is set forth in 37 CFR 1.17(l). Thus, unless the circumstances warrant the withdrawal of the holding of abandonment (i.e., it is determined that the application is not properly held abandoned), the payment of a petition fee to obtain the

² Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

³ Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

revival of an abandoned application is a statutory prerequisite to revival of the abandoned application, and cannot be waived.

In addition, the phrase "[o]n filing" in 35 U.S.C. 41(a)(7) means that the petition fee is required for the filing (and not merely the grant) of a petition under 37 CFR 1.137. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6 (1982), reprinted in 1982 U.S.C.C.A.N. 770 ("[t]he fees set forth in this section are due on filing the petition"). Therefore, the Office: (A) will not refund the petition fee required by 37 CFR 1.17(l) or 1.17(m), regardless of whether the petition under 37 CFR 1.137 is dismissed or denied; and (B) will not reach the merits of any petition under 37 CFR 1.137 lacking the requisite petition fee.

Thus, the entire petition fee under 37 CFR 1.137(b) must be paid to obtain consideration under 37 CFR 1.137(b). As petitioner has authorized "the difference in the petition fees and any other required fees" to be charged, the entire petition fee under 37 CFR 1.137(b) will be charged as required to obtain consideration under 37 CFR 1.137(b).

Receipt of the amendment filed on January 30, 2009 in response to the non-final Office action mailed on April 15, 2008 is acknowledged.

The application will be forwarded to Technology Center Art Unit 2456 for further processing.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3231.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions